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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NEWTON B. WHITE, JR.

Appeal 2007-2251
Application 09/381,742
Technology Center 3600

Oral Hearing Held: December 19, 2007

Before HUBERT LORIN, ANTON W. FETTING, JOSEPH A.
FISCHETTI, Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

CARL OPPEDAHN, ESQUIRE (via videoconference)
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The above-entitled matter came on for hearing on Wednesday, December
19, 2007, commencing at 9:58 a.m., at the U.S. Patent and Trademark
Office, 600 Dulany Street, Alexandria, Virginia, before Beverly J. Mahoney,
Notary Public.

1 PROCEEDINGS
2

3 JUDGE LORIN: Counsel, we are in session now. We see you
4clearly. This is Appeal Number 2007-2251. You have 20 minutes. When
5you're ready, you may proceed.

6 MR. OPPEDAHL: Good morning. I will reserve five minutes for
7rebuttal after the examiner. Is the examiner present?

8 JUDGE LORIN: No, the examiner is not present.

9 MR. OPPEDAHL: Then I will proceed. I invite questions from the
10board, of course, as we proceed. We have 16 issues to cover and 20 minutes
11to cover our 16 issues. I prefer to focus on any particular issues that Your
12Honors may find most deserving of the time.

13 First, I will just give a moment's comment to the first issue on appeal.
14The first issue on appeal is directly to claim 196. And this is -- I will
15suggest that this is essentially a signal claim, a claim that recites a sequence
16of ones and zeros.

17 Of course, what we would urge to the board is that, just like any signal
18claim that has the possibility of being patentable subject matter, the chief
19questions then would be whether it's novel and unobvious.

20 And we suggest that since the examiner has not raised issues of
21novelty or unobviousness, that so far as the first issue on appeal is
22concerned, we suggest that reversal of the rejection be in order.

23 JUDGE LORIN: Counsel, you are aware of the recent case in the
24Federal Circuit decision in Nuijten, which held that signal claims are not
25patentable subject matter. Would you like to speak to that?

26 MR. OPPEDAHL: That case was not cited by the examiner, Your

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1Honor.

2 JUDGE LORIN: Are you then suggesting that we should reverse
3without addressing that case?

4 MR. OPPEDAHL: No. I'm just suggesting that if the case had been
5cited by the examiner, we would have been in a position both to address it in
6our reply and would have been in a position to comment on whatever the
7examiner said characterizing the case.

8 JUDGE LORIN: So what is your view? How should we proceed
9with this claim with that case available to us?

10 MR. OPPEDAHL: Well, it's a tough situation. This appeal was fully
11briefed more than three years ago. And had the case been decided -- had the
12appeal been decided at all, within even a few months of when it was fully
13briefed, it could have been decided based on the law the way it was at the
14time it was briefed.

15 I guess the board has no choice but to decide the case based on things
16that happened after this was fully -- in the three years that have passed since
17this case was fully briefed.

18 Well, if I may, let me press on to some of the other issues on appeal.
19We have several issues on appeal that relate to a cited reference, Adams.

20 And in several instances we have claims that are rejected under
21Section 102 as being supposedly anticipated by Adams. The --

22 JUDGE LORIN: Counsel, can I stop you for a second. You seem to
23be moving on to issues of prior art. But I notice that there are also pending
24issues under 101 with respect to a number of your claims. Would you
25address that first, please.

26 MR. OPPEDAHL: Yes, Your Honor.

1 The patentable subject matter, Section 101 rejections, for example, the
2second issue on appeal, of course, the chief thing that has happened since the
3case was fully briefed is more recent opinions that say that it is not necessary
4to have technological arts in the claim for it to be patentable subject matter,
5and that really the chief requirement is that there be concrete tangible result.

6 At the risk of oversimplifying, the changes in the law relating to
7Section 101 that have occurred since these briefs were filed are changes that
8affect the case only in the direction of furthering our appeal, make it more
9favorable to the appellant.

10 So we have -- in the briefs we discuss at some length the concrete and
11tangible results that can be found in the claims. In many cases the examiner
12did not raise a question of whether a concrete or tangible result was present
13in the claim.

14 Indeed, for most of these claims the examiner only raised
15technological arts issues. So given those changes in the law, my suggestion
16would be that, as to the patentable subject matter issue on appeal, that that
17should be reversed.

18 JUDGE FETTING: Do you have a view as to whether Comiskey, the
19recent opinion from the Federal Circuit, which stated that a claim that's
20wholly drawn to mental steps, whether that case applies to, for instance,
21claim 169?

22 MR. OPPEDAHN: It is not the case that these claims are mental steps
23claims. For example, claim 169 there is a sending of a reply. A sending of a
24reply is not simply a mental step. A sending of a reply is more than
25somebody just thinking, Oh, yes, I have received a request, or I have
26received something.

1 Indeed, receiving a request is also more than a mental step. It
2 involves receiving a communication from elsewhere. There is very little in
3 claim 169 that could be characterized as mere mental steps.

4 The same can be said about many of the other claims. Claim 170,
5 which has some 30 limitations, has implicit in it that there is the limitations
6 of the independent claim from which it depends, in which there is sending of
7 a reply.

8 In the appellant's brief we analyze one by one particular items of
9 concrete and tangible result that can be found in each of the claims that were
10 rejected relating to subject matter.

11 In each case we have listed, for example, receiving of information,
12 sending a reply, publishing information and so on. So in each case there are
13 limitations presented. They are more than mere mental steps.

14 JUDGE FETTING: For example, in claim 169, could the receiving
15 and sending encompass oral communications?

16 MR. OPPEDAHN: This is, of course, a method claim with steps in it.
17 And of course, under the last sentence of Section 112 the steps are construed
18 as those steps set forth in the specification, together with the equivalence
19 thereof.

20 The only steps set forth are embodiments that involve communicating
21 messages between different entities, typically one of which is a computer, or
22 a system, physical system.

23 So you have a situation where the -- you know, the only embodiments
24 set forth for those method steps are essentially performed with computers
25 and other physical systems.

26 JUDGE FETTING: Did I gather that you are contending that claim

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1169 is being construed under 112, sixth paragraph?

2 MR. OPPEDAHN: That the method steps -- well, I suppose the best
3way to put this is it's -- the best way to put this is that the claim is construed
4with respect to what is in the specification.

5 And what is in the specification is only computer and other steps
6carried out by physical apparatus. Nowhere in the specification do we have
7human beings speaking things to each other, that that is somehow how these
8steps are carried out. That's just nowhere in the specification.

9 So regardless of whether the Patent Office were to take the position
10that these are step plus function elements, or whether the Patent Office or the
11Federal Circuit were not to take the position that step plus function -- in
12either case there is this perspective of the specification, in which the only
13recited ways of doing this are with computer and physical systems.

14 JUDGE FETTING: You may proceed.

15 MR. OPPEDAHN: Just looking at the clock.

16 If I may, with our limited time, move forward to the rejections, the
17fifth issue on appeal and the other issues on appeal that relate to the Section
18102 rejections with respect to the reference Adams.

19 The appellant's brief goes on in some length detailing particular
20limitations in the rejected claims that we simply cannot find in Adams.

21 We can't find in Adams by sitting and reading it, as people would
22normally read it. If we bring up the full text of Adams and just do text
23searches, there are whole words that we simply can't find in Adams.

24 When the rejection came in, back before the case was on appeal, we
25cited the case of In Re Alhert and Kruger, asking the examiner to please
26state the basis for the view that certain limitations could be found in Adams.

1And the examiner never did that.

2 So we went to appeal with situations where there was literally no
3showing where certain of those limitations could be found in Adams.

4 When we filed our appeal brief we then detailed elements, limitations
5in the claims, that we couldn't find in Adams. And we, of course, were in a
6position when we received the examiner's brief to read the examiner's brief
7to see if the examiner had addressed those missing limitations. And we
8couldn't find it in the examiner's brief.

9 So I suggest to the board that there is a quite clear record that the
10Section 102 anticipation rejections of claims over Adams, each one of them,
11we suggest, fails because of at least one limitation that the examiner never
12did show to be found anywhere in Adams.

13 So those are my comments about Section 102, rejections over Adams.
14There are a few issues on appeal: 11th, for example, and 12th, where the
15rejection is an obviousness rejection, a Section 103 rejection over Adams.

16 There we have, first, some missing elements, which would not
17necessarily be fatal to a rejection. But in addition to missing elements, as we
18detail in the appellant's brief, there are several places in, for example, the
1911th and 12th issues on appeal, several places where we urge that Adams
20actively teaches away from what is said in our claim.

21 So it is our suggestion that it's not merely that there are missing
22elements, missing limitations, but also that Adams couldn't render those
23claims, those obviousness rejected claims, that Adams could not render
24those claims unpatentable because it teaches away from what is in those
25claims.

26 In particular, teaching away from publishing in the ordinary plain

1English sense of making some information available to the general public.

2 So there are my comments, our comments, with respect to the 103
3rejections with Adams, and Adams when combined with the second
4reference.

5 I would like to just take a moment to review my notes to see how to
6allocate the remaining time. It should just take a moment.

7 (Pause in the proceedings.)

8 MR. OPPEDAHN: The next issue that I would like to address for the
9board is the third issue on appeal. The third issue on appeal has to do with --
10to give an example, claim 177.

11 Claim 177 is a method claim. The method claim includes, for
12example, a digital signature. And then in addition to there being a digital
13signature, the method calls for using a separate means of securing
14communication, other than the digital signature.

15 By way of background or perspective, of course, what we're looking
16at is a situation where in many cases digital signatures are used in part to
17provide assurance to a recipient that the message really came from whoever
18it purports to have come from, if the digital signature represented a signature
19by the sender, for example.

20 Here in the claim we are talking about securing the message in a
21separate manner, in a separate manner distinct from that of the digital
22signature.

23 What we have in the office actions, and what we have in the
24examiner's brief, is a ground for rejection that I find difficult to know how to
25respond to in plain language, or in plain English.

26 The examiner essentially says, Once you have a digital signature, I

1can't think of any reason why you would also secure the message in some
2other way.

3 It strikes me that those words from the examiner are essentially an
4admission of unobviousness. That if what is recited in the claim is
5something that the examiner can't imagine anybody would ever think to do, I
6take that as the very indication of unobviousness. That the examiner's
7inability to see why somebody would do that ought not to be grounds for
8rejection.

9 And yet it's the very situation, as far as I can tell, that we face in the
10wording of the rejection, both as set forth in the Office actions and as recited
11in the examiner's brief.

12 Turning to the fourth issue on appeal, we have 112 rejections where
13the examiner -- well, without much detail or explanation, the examiner
14rejects about nine claims. And in each case computer apparatus are
15explicitly set forth in the claims.

16 Claim 169, for example, claim 169 explicitly says that a computer
17apparatus is included. That language, the language in parentheses, Which
18system includes without limitation a computer apparatus, is language that
19got added during prosecution because the examiner kept saying that the
20examiner wanted to see "computer apparatus" in the claim.

21 So the applicant did finally put in amendments saying that, yes, the
22system includes a computer apparatus. And what we have is the examiner
23saying that that's indefinite somehow, that because we said there could be
24something else in addition to a computer apparatus, that that makes it
25indefinite.

26 I have been drafting claims for many years, and I am used to the idea

1that when we draft a claim and the claim says that the apparatus contains an
2A, a B and a C, that, of course, the apparatus could also contain a D, E or an
3F, and that this shouldn't surprise anyone that that might be the case, that the
4apparatus might contain more things than what is listed in the claim.

5 And yet that's the very ground for rejection that gave rise to the fourth
6issue on appeal, this limitation that says that there is computer apparatus and
7there could be something else.

8 JUDGE LORIN: Counsel, have you seen this before in your
9experience, this parenthetical information in a claim?

10 MR. OPPEDAHL: It's not a question of whether we saw it or not.
11We were in a telephone interview with the examiner, who said that that
12would overcome a particular concern.

13 So we put it in based on a telephone review. It's frustrating to us to
14find out that later the examiner didn't like the very thing that the examiner
15had suggested be added.

16 JUDGE LORIN: You are saying the examiner suggested that you put
17this parenthetical information in the claim?

18 MR. OPPEDAHL: Yes.

19 JUDGE LORIN: Which is what you did?

20 MR. OPPEDAHL: Yes.

21 JUDGE LORIN: It's hard to tell because, you know, when you see
22something parenthetical, you get the impression that it's -- you know, it may
23be included and, you know, it may not be included. It's hard to say.

24 MR. OPPEDAHL: Well, I respectfully suggest otherwise. Looking
25at claim 169, for example, Which system includes without limitation a
26computer apparatus.

1 I take that to be quite clear, quite definite. It is putting forth that the
2system includes a computer apparatus. I don't see anything fuzzy or
3questionable about that.

4 I can't see anything about those words or that punctuation to
5question whether the system does or does not include a computer apparatus.

6 JUDGE FETTING: Maybe I'm reading a little weird. But to me the
7phrase "without limitation" reads out potentially the computer apparatus.
8You are saying "includes without limitation." So doesn't "without
9limitation" suggest the possibility of not including it?

10 MR. OPPEDAHN: No. No. "Without limitation" means other things
11could be included as well. It could be a computer apparatus plus a ping-
12pong ball. It could be a computer apparatus plus a paper clip. "Includes
13without limitation," meaning, yes, computer apparatus, but we're not limiting
14it to a computer apparatus.

15 There could also be a power plug or a battery or something else.

16 JUDGE FISCHETTI: Counsel, haven't you already stated that as a
17practitioner you understood that these claim construction automatically and
18inherently understands that A, B and C are mandated, but you can still have
19a D, F and G?

20 So my question is, why bother with the "without limitation" if that
21understanding is already prevalent in your drafting technique?

22 MR. OPPEDAHN: This came from a telephone conversation,
23telephone conference, with the examiner. And unfortunately, I did what the
24examiner said in the phone call and, you know, that's the way it is. We
25could amend this, we could change it to say, Which includes a computer
26apparatus; it may include other things, but that's not helpful.

1 It's not helpful to say "may include," because that sounds like
2something is optional. We all know that we can't be putting optional things
3in the claims.

4 JUDGE LORIN: Well, your position is that -- what you are trying to
5say here is that this method for operating the system includes at least a
6computer?

7 MR. OPPEDAHN: Includes at least a computer apparatus, yes. It
8would be like a chair with at least three legs. And yes, sometimes chairs
9have four legs. If I say "at least three legs," I don't see that that makes it
10indefinite. That the possibility of a fourth or fifth leg being on the chair, I
11don't see how that introduces any more indefiniteness at all.

12 This case has had a long and tortured examination. And, you know,
13this is the second appeal already in this case. And there are a lot of things
14about the claims that are not the way they were drafted in the first place,
15because of things that the examiner said and the objections that the examiner
16raised.

17 I wouldn't have chosen that. I did not choose that language when the
18case was first drafted. When I drafted these claims nine years ago, I didn't
19have those words in there.

20 Drawing upon my experience, I didn't put in those words, but they got
21there because of the prosecution.

22 I see that I have used up my time. I welcome the opportunity to
23answer any further questions Your Honors may have. Otherwise, I will
24thank you for your time.

25 JUDGE LORIN: No, Counsel, it looks like we have no further
26questions. Thank you. And we will take your comments under advisement.

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1 MR. OPPEDAHL: Thank you. Good day.

2 JUDGE LORIN: Good day.

3 (Whereupon, the proceedings at 10:20 a.m. were concluded.)